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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,186	04/07/2004	Thomas R. Marsh	9066-23DV	7421
20792	7590	12/14/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			LUGO, CARLOS	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,186

Applicant(s)

MARSH ET AL.

Examiner

Carlos Lugo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: attachment #1.

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DETAILED ACTION

- DPS
1. This Office Action is in response to applicant's ^{request for} reconsideration filed on November 18, 2004.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered:
- The first and second confronting furniture components with the device as claimed in claim 1 (drawn to Figure 1).
 - How the device is attached to one of the first and second components (claim 1).
 - The cushioning projection having at least an opening in an end (claim 9).

The presents set of claims is directed to the embodiment illustrated in Figure 1, wherein the device only have a base member, a cushioning projection defining and covering a void between the base member and the structure of the cushioning projection. The drawing (Figure 1) however, fails to illustrate the first and second confronting furniture components and how the base is attached to one of those components.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The

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figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. **Claim 11 is objected** to because of the following informalities:
- Claim 11 Line 2, change "thickness of between about .020 and about .090 inches" to -thickness between .020 and .090 inches-.
- Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
5. **Claims 4-6 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation that "the projection has a convex portion extending outwardly from the second face of the base member and a planar portion opposite the convex portion across the void". It is unclear to which planar surface the applicant is referring to. According to Figure 1 of the present application, the projection has a convex portion extending outwardly from the second face of the base member and a planar surface opposite the convex portion, but not across the void. The planar surface across the void is the one at the base member, not at the projection. Therefore, in order to continue with the examination, the planar surface across the void will be considered as part of the base member, not as part of the projection.

As to claim 5, the limitations presented in the claims will be considered as a difference in thickness between the planar surface and the main surface of the base member.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-4,7,8,10, and 11 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,185,161 to Tinnerman.

Regarding claim 1, Tinnerman discloses a device (C) for protecting first and second confronting furniture components (A and B).

The device comprises a base member having opposite first and second faces (see Attachment #1). The first face is adapted to contact the first furniture component (B). The base member has a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member (Figures 1 and 2, see Attachment #1). The projection is adapted to contact the second furniture component (A) as it confronts the first furniture component.

As to claim 2, Tinnerman illustrates that the device is formed as a unitary member (Figures 1 and 2).

As to claim 3, Tinnerman discloses that the device is formed of a polymeric material (Col. 2 Lines 38-45).

As to claim 4, Tinnerman illustrates that the projection has a convex portion extending from the second face of the base member and a planar portion across the void at the second face of the base member (when the projection is compressed, Figure 2).

As to claim 7, Tinnerman illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member (Figures 1 and 2).

As to claim 8, Tinnerman illustrates that the cushioning projection is generally semi-circular.

As to claim 10, Tinnerman illustrates that the cushioning projection is closed at both ends.

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As to claim 11, Tinnerman illustrates that the cushioning projection could have a thickness of between .020 and .090 inches.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 6 and 9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman as applied to claim 1, in view of US Pat No 2,161,648 to Widman.

As to claim 6, Tinnerman fails to disclose that the convex portion has a thickness that is less than the thickness of the main surface of the base member. Tinnerman illustrates that the thickness are substantially the same.

Widman teaches that it is well known in the art to have a cushioning device comprising a projection with a convex portion extending from a base portion and having a thickness less than the thickness of the base member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the difference of thickness, as taught by Widman, into a device as described by Tinnerman, in order to create a simple device with less material and to create a better sealing between the surfaces in place.

As to claim 9, Tinnerman fails to disclose that the cushioning projection comprises an opening at least one end.

Widman teaches that it is well known in the art to have a cushioning device that comprises an opening in at least one end (Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an opening in at least one end, as taught by Widman, into a device as described by Tinnerman, in order to create a simple device with less material that will perform as well as a device without an opening at least one end.

Allowable Subject Matter

10. **Claim 5 would be allowable** if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Reasons For Allowable Subject Matter

11. The following is an examiner's statement of reasons for allowable subject matter:

Claim 5 present allowable subject matter over the prior art of record because the teachings of the references taken as a whole do not teach or render obvious the combination set forth, including that the planar portion opposite the convex portion across the void at the base member has a thickness less than the thickness of the main surface of the base member.

Tinnerman (US 2,185,161) and Widman (US 2,161,648) fail to disclose that the planar portion opposite the convex portion across the void at the base member has a thickness less than the thickness of the main surface of the base member.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

12. As to applicant's arguments with respect to the double patenting rejection; the arguments have been fully considered and are persuasive. During the prosecution of US Pat Application No 10/268034, now US Pat No 6,729,664, a restriction was made to claims 1-54 presented in that application. The applicant elects to examine Group II, drawn to claims 12-53. The current application is drawn to Group I of the parent case. Therefore, the double patenting rejection of claims 1-11 has been withdrawn.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

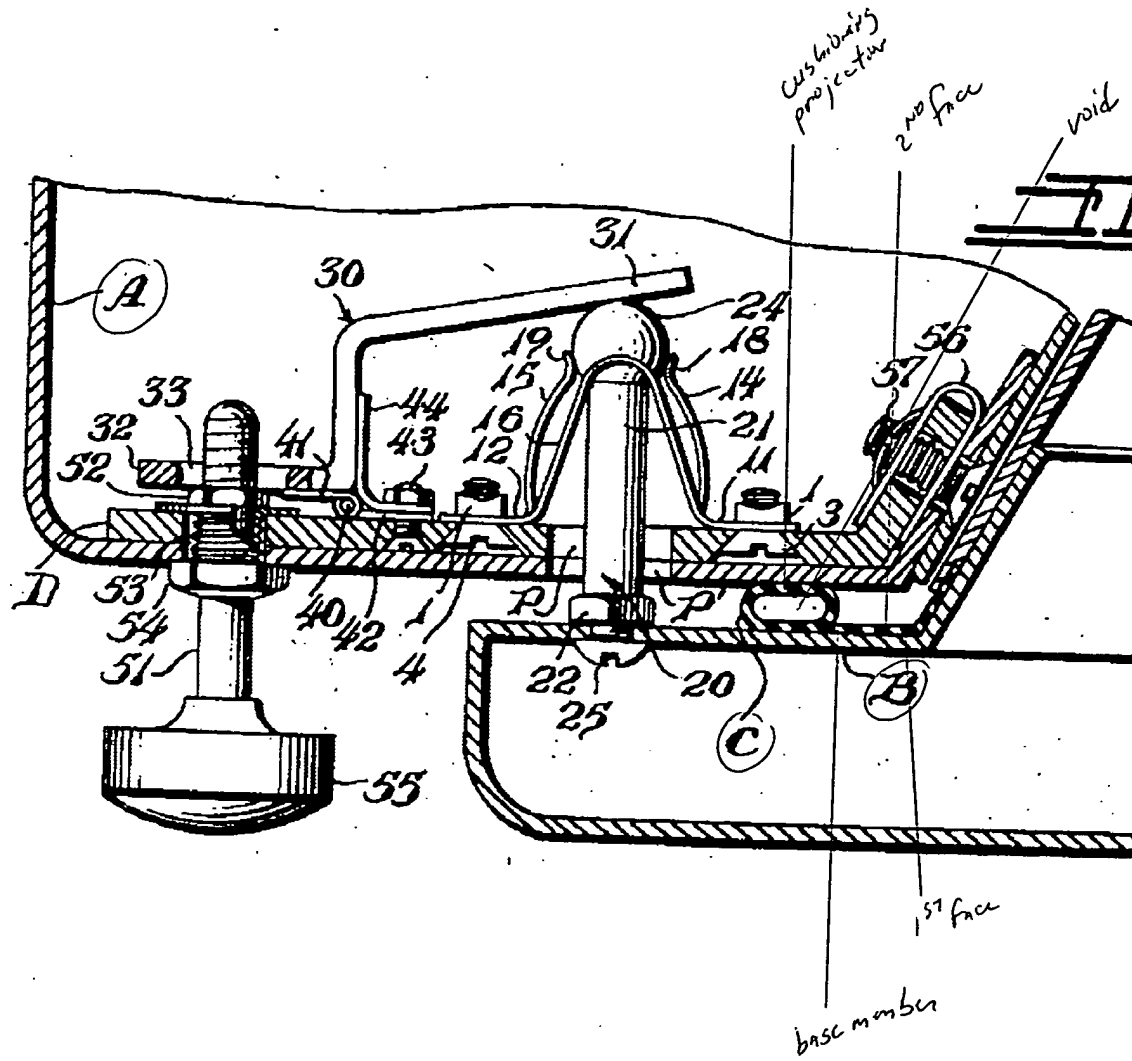
C. L.

Carlos Lugo
AU 3676

December 4, 2004

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large, looped initial 'D'.

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600



Attachment #1